UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,804	11/24/2003	Richard L. Kulp	GB920030079US1	5413

53792   7590   05/13/2008
DILLON & YUDELL LLP
8911 N. CAPITAL OF TEXAS HWY.
SUITE 2110
AUSTIN, TX 78759

EXAMINER
DAM, KIM LYNN

ART UNIT	PAPER NUMBER
2179	

MAIL DATE	DELIVERY MODE
05/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/720,804
Filing Date: November 24, 2003
Appellant(s): KULP ET AL.

James E. Boice

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/5/08 appealing from the Office action

mailed 7/13/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is incorrect.

The amendment after final rejection filed on 2/11/08 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

substantially correct. The changes are as follows: Appellants cited the Hama reference

as USPN. 5,574,177, which is a typo, and is really USPN 5,754,177.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,754,177   Hama   5-1998

5,627,959	Brown	5-1997
6,335,733	Keren	1-2002
5,377, 314	Bates	12-1994
5,651,107	Frank	6-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 5-10, 15-17, 19-24, and 28-32 are rejected under U.S.C. 103(a) as being

unpatentable over Hama et al. (USPN 5,574,277) in view Brown et al. (USPN

5,627,959) and in further view of Applicant's own admitted prior art (Background

section).

Regarding claim 1, Hama disclosed a method for performing an operation on a graphic

object in a display of overlapping graphic objects in a data processing system, the

method comprising the steps of:

displaying a plurality of overlapping graphic objects to a user (Abstract, lines 1-3;

Column 1, line 65 to Column 2 line 9; Fig. 7 and 8);

detecting a position of a pointer with respect to a display of said plurality of

overlapping graphic objects (Abstract, lines 3-4; Col. 3, lines 37-39 and 52-59);

displaying to a user a list of overlapping graphic objects which coincide with said

pointer position and on which said graphics editing operation can be performed

(Abstract, lines 3-13; Col. 3, line 52 to Col. 4 line 3; where editing operation is inherently performed on the selected edit object);

Hama does not specifically teach detecting a selection by the user of one graphic object of said indicated plurality of overlapping graphic objects as a target object without the user changing said pointer position to make said selection. However, selection of an object from a menu or subscreen without the user changing said pointer position, for example keyboard arrow buttons to move along choices and enter button to select, is well known and expedient in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate these selection means without changing the pointer position in order to allow the user to make selections without losing their current pointer position.

Hama does not explicitly teach detecting a selection by the user of a graphics editing operation to be performed on a graphic object, performing said graphics editing operation on said target graphic object; and making said target graphic object visible during performance of the graphics editing operation on said target graphic object. However, these limitations are obvious in view of Hama since Hama teaches selection of an edit object. It is well known in the art that selection and performance of editing operations happen when an edit object is selected as also shown in applicant's own admitted prior art (Background, Page 1, lines 15-20).

Hama does not specifically disclose storing a model of a graphic object, wherein said model includes an indication of whether said graphic object is a parent or child of another graphic object. However, in an analogous art, Brown teaches storing graphic

objects with indication of whether an object is a parent or child of another object (Figures 2,3A, 3B, and Figure 4 (layered objects); Column 8, lines 13-25, where layers are defined as children of the root object). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Brown into the system of Hama in order to keep track of related objects.

Regarding claim 2, the rejection of claim 1 is incorporated and neither Hama nor Brown specifically teach wherein said position of a pointer comprises a user-defined area of said display described by the motion of said pointer in response to said user dragging an input device. However, use of a pointer to define an area, for example dragging the input device to draw a box around a selected area, is well known and expedient in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate selecting a user-defined area using a pointer, since that would allow users to specifically define an area on the display.

Regarding claim 3, the rejection of claim 1 is incorporated and further Applicant's own admitted prior art disclosed wherein said step of selecting the graphics editing operation comprises detecting a user input identifying selection of a graphics editing tool (Background, Page 1, lines 15-22).

Regarding claim 5, the rejection of claim 1 is incorporated and further Applicant's own admitted prior art disclosed wherein said step of selecting the graphics editing operation

to be performed comprises selecting a source graphic object and said step of performing the graphics editing operation comprises dropping said source graphic object onto said target graphic object (Background, Page 1, line 26 to Page 2 line 13, where selected source object can be dropped onto the target object).

Regarding claim 6, the rejection of claim 1 is incorporated and further Hama disclosed comprising the step of storing the positions of said plurality of overlapping graphic objects on said display and comparing said pointer position with said graphic object positions to determine which graphic objects are coincident with the pointer (Figure 2, element 3; Col. 2, lines 44-50; Col. 3, lines 42-59).

Regarding claim 7, the rejection of claim 1 is incorporated and further Hama disclosed comprising the step of maintaining a record of attributes relating to each of said graphic objects (Figure 2, element 3; Col. 3, lines 47-52).

Regarding claim 8, the rejection of claim 1 is incorporated and further Hama disclosed wherein said displaying step comprises continuously displaying to the user a hover window listing said graphic objects which are coincident with said pointer position and continuously updating said hover window in response to changes in said pointer position (Abstract, lines 10-11; Col. 2, lines 50-53; Col. 3 line 66 to Col. 4 line 13; Col. 4, lines 33-36, where contents of hover window change in response to pointer position).

Regarding claim 9, the rejection of claim 1 is incorporated and neither Hama nor Brown specifically discloses wherein said graphics editing operation comprises adding text to said target object. However adding text is a graphics editing operation that is well known and expedient in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate adding text as a graphics editing operation to an object, since that allows users to integrate text into the graphics.

Regarding claim 10, the rejection of claim 1 is incorporated and neither Hama nor Brown specifically discloses wherein said graphics editing operation further comprises the steps of:

opening a text box on said target graphic object;

displaying a text insertion cursor in said text box to display the location where new text will be inserted; and

ending said graphic operation in response to the user moving said pointer to a position outside of said text box and depressing a control button on an input device. However, these steps taken to add text to objects are well known and expedient in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate these steps to add text as a graphics editing operation to an object, since that allows users to integrate text into the graphics.

Regarding claim 15, the rejection of claim 1 is incorporated and Hama inherently disclosed wherein said step of displaying an indication of coincident graphic objects is

dependent on said position of the pointer remaining the same for a certain period of

time (Abstract, lines 3-13; Col. 3, line 52 to Col. 4 line 3; where editing operation is

inherently performed on the selected edit object).

Regarding claims 16, 17, 19, 20, 21, 22, 23, and 24, the limitations have been

addressed in the rejection of claims 1, 2, 5, 6, 7, 8, 9, and 10 respectively. Therefore

claims 16, 17, 19, 20, 21, 22, 23 and 24 are rejected under the same rationale as

applied above.

Regarding claim 28 and 29, they are the program element comprising program code for

executing the software tool of claim 16.   Therefore claims 28 and 29 are rejected under

the same rationale as applied above.

Regarding claim 30, it is the program element comprising instructions for performing the

method of claim 1. Therefore claim 30 is rejected under the same rationale as applied

above.

Regarding claim 31, Hama inherently disclosed a solid-state memory.

Regarding claim 32, the rejection of claim 16 is incorporated and Hama discloses a data

processing system comprising a software tool according to claim 16 (Figure2).

Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hama et al. (USPN 5,754,177) Brown et al. (USPN 5,627,959), Applicant's own admitted prior art (Background section) and further in view of Keren et al. (USPN 6,335,733).

Regarding claim 4, the rejection of claim 3 is incorporated and neither Hama nor Brown specifically disclose changing the form of said pointer on said display in response to detection of said user input selection. However Keren disclose the above limitation (Col. 5, lines 14-16 and 48-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Keren into the system of Hama in order to allow users to efficiently visualize the interchange of one operation to another.

Regarding claim 18, the limitations were addressed in the rejection of claim 4. Therefore claim 18 is rejected under the same rationale as applied above.

Claims 11 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hama et al. (USPN 5,754,177) in view Brown et al. (USPN 5,627,959), Applicant's own admitted prior art (Background section) and further in view of Bates et al. (USPN 5,377,314).

Regarding claim 11, the rejection of claim 10 in incorporated neither Hama nor Brown specifically disclose the step of determining whether said target graphic object is the

outermost one of said graphic objects which are coincident with the position of the

pointer.   However, Bates disclosed the above limitation (Col. 5, line 59 to Col. 6, line 4).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to incorporate the teachings of Bates into the system of Hama in order to

allow the determination of the outermost object based on the order which objects

appear in the z-axis (Bates Col. 6, lines 2-4).

Regarding claim 25, the limitations have been addressed in the rejection of claim 11.

Therefore claim 25 is rejected under the same rationale as applied above.

Claims 12-14 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Hama et al. (USPN 5,754,177) in view Brown et al. (USPN 5,627,959) , Applicant's

own admitted prior art (Background section), Bates et al. (USPN 5,377,314) and further

in view of Frank et al. (USPN 5,651,107).

Regarding claim 12, the rejection of claim 11 is incorporated and neither Hama, Brown,

nor Bates disclose wherein the step of making said target graphic object visible

comprises temporarily making at least the outermost one of said coincident graphic

objects transparent. However, Frank disclosed making coincident graphic objects

transparent (Abstract, lines 17-25). It would have been obvious to one of ordinary skill

in the art at the time the invention was made to incorporate the teachings of Frank into

the system of Hama, Brown and Bates in order to make underlying data or graphics

visible to users (Bates, Abstract, lines 22-25; Col. 2, lines 49-55).

Regarding claim 13, the rejection of claim 12 is incorporated and neither Hama, Brown,
Bates nor Frank expressly teach wherein the outermost coincident graphic object is a
child graphic object to a parent graphic object and the step of making the selected
target graphic object visible comprises temporarily making said parent graphic object
transparent in response to making said child graphic object transparent.   However,
making the parent and child graphic object transparent in order to make the selected
target visible would have been obvious to one of ordinary skill in the art at the time the
invention was made in view of Hama, Brown, Bates and Frank, they all disclose
overlapping graphic objects, Brown teaches parent child graphic relationships and
Frank teaches making objects transparent in order to make underlying data or graphics
visible to users (Bates, Abstract, lines 22-25; Col. 2, lines 49-55).

Regarding claim 14, Frank inherently discloses graphic objects, which reappear
automatically after the operation has been performed on said target object.

Regarding claims 26 and 27, the limitations have been addressed in the rejection of
claims 12 and 13 respectively. Therefore claims 12 and 13 are rejected under the same
rationale as applied above.

(10) Response to Argument

Beginning on page 5 of Appellant's brief (hereinafter Brief), Appellant argues specific issues, which are accordingly addressed below.

In response to Appellant's argument regarding the rejection of exemplary claim 1, that the combination of Hama, Brown and Appellants' APA does not render obvious the step of "displaying to a user a list of overlapping graphic objects which coincide with said pointer position and on which said graphics editing operation can be performed" (Brief pages 5-6), the Examiner respectfully disagrees.

In the final office action mailed 7/13/07, the examiner outlined the rejection of claim 1 and explained the rationale for the above limitation. Hama teaches "displaying to a user a list of overlapping graphic objects which coincide with said pointer position and on which said graphics editing operation can be performed (Abstract, lines 3-13; Col. 3, line 52 to Col. 4, line 3). Hama displays selective candidates on which graphics editing operations can be performed, as claimed.

Appellant argues that, "the clause "on which said graphics editing operation can be performed" describes the list of overlapping graphic objects that are displayed to the user. For example, if the user selects a paint operation, then the list displayed to the user will only display overlapping graphic objects that an be painted. Overlapping graphic objects that cannot be painted will not be displayed in the list". In response to

applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. only displaying overlapping objects that can be edited and not displaying objects that cannot be edited) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Hama displays to the user a list of overlapping objects which coincide with said pointer position and on which said graphics editing operations can be performed, as claimed.

In response to Appellant's argument regarding exemplary Claim 1, that the combination of Hama, Brown and Appellants' APA does not render obvious the step of "detecting a selection by the user of one graphic object of said indicated plurality of overlapping graphic objects as a target graphic object without the user changing said pointer position to make said selection" (Brief, page 7), the Examiner respectfully disagrees.

In the final office action, the examiner out outlined the rejection of claim 1 and explained the rationale for the above limitation. Hama does not specifically teach detecting a selection by the user of one graphic object of said indicated plurality of overlapping graphic objects as a target object without the user changing said pointer position to make said selection. However, selection of an object from a menu or subscreen without the user changing said pointer position, for example keyboard arrow

buttons to move along choices and enter button to select, is well known and expedient

in the art. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to incorporate these selection means without changing the pointer

position in order to allow the user to make selections without losing their current pointer

position.

Appellant argues that "Hama relies on moving a pointer to make selections of

objects, which teaches away from Applicant's claimed invention. Therefore, it would not

be obvious to one skilled in the art at the time of the invention to combine making

selections without changing the position of a pointer with Hama, which teaches moving

a pointer to select graphic objects". In response, the examiner directs the appellant to

MPEP §2123 where Disclosed examples and preferred embodiments do not constitute

a teaching away from a broader disclosure or non-preferred embodiments. In re Susi,

440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not

become patentable simply because it has been described as somewhat inferior to some

other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130,

1132 (Fed. Cir. 1994). Furthermore, "[t]he prior art's mere disclosure of more than one

alternative does not constitute a teaching away from any of these alternatives because

such disclosure does not criticize, discredit, or otherwise discourage the solution

claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

In this case, Hama teaches use of a pointer, but as the Examiner states above

and in the final office action, selection of an object from a menu or subscreen without

the user changing said pointer position, for example keyboard arrow buttons to move

along choices and enter button to select, is well known and expedient in the art. It

would have been obvious to one of ordinary skill in the art at the time the invention was

made to incorporate these selection means without changing the pointer position in

order to allow the user to make selections without losing their current pointer position.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kim-Lynn Dam/

Conferees:
/Weilun Lo/
Supervisory Patent Examiner
Art Unit 2179

Ba Huynh
Primary Examiner
Art Unit 2179
/Ba Huynh/

Primary Examiner, Art Unit 2179

Dillon & Yudell LLP
8911 N. Capital of Texas Highway
Suite 21110
Austin, Texas 78759